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EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/966,634

Applicant(s)

STEPANENKO ET AL.

Examiner

Hargobind S Sawhney

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8, 11, 12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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1. The amendment filed on December 9, 2002 has been entered. Accordingly:
  - The specification has been revised;
  - Claims 1, 6, 14 and 15 have been amended; and
2. The applicant's request made through the amendment filed on December 9, 2002 for examining the previously cancelled claims 20-22 has been considered. Based on further consideration claims 20-22 require restriction as detailed below.

***Election/Restriction***

3. Restriction to the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-19, drawn to a combination – an integrated light and accessory assembly – classified in class 362, subclass 240.
  - II. Claims 20-232, drawn to sub-combination – method of manufacturing a printed circuit board and an integrated light assembly--, classified in class 438, subclass 455.

Inventions II and I are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and (2) that the sub-combination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed.

Therefore, patentability of the combination – an integrated light and accessory

assembly - does not rely on the method of manufacturing a printed circuit board and an integrated light assembly claimed in claims 20-22. Further, the sub-combination- printed circuit board- has separate utility such as its use for illuminated display including LCDs, microcomputers and telephone displays.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

### ***Claim Objections***

4. Claims 14-19 are objected to because of the following informalities:

Claim 14 recites the limitation " the controller" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. This application has been examined considering the limitation " the controller" as " the electronic module".

Claims 15-19 are also objected because of their dependency on the objected base Claim 14.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLine et al. (U.S. Patent No. 6,124,886).

Regarding claims 1-5, DeLine et al. ('886) discloses an integrated light and accessory assembly 10 (Figure 1, column 7, line 17) comprising:

- an insulator 20 (Figure 1, column 7, lines 22 and 23) and reflectors 110 and 112 (Figure 1, column 7, line 35 ) mounted on the insulator 20 (Figure 1)
- a conductor 62 (Figures 1 and 4, column 9, lines 12,13,18,19 ,64 and 65) being connected to the insulator 20 (Figures 1 and 4);
- a plurality of lamps 130 (Figure 1, column 7, lines 34-38) being connected to the conductor 62, and assembled inside the respective reflectors 110 and 120 (Figure 1, column 7, lines 15-18);
- a control module 72a (Figure 1, column 7, lines 15-18) – the box housing the wiring connections associated with the switch is considered as a module – mounted on the insulator 20 (Figure 1);
- a housing 12 (Figure 1, column 7, lines 18 and 19) enclosing the insulator 20, the reflectors 110 and 112, the conductor 62 and the control module 72a;

- the lamp 130 being an incandescent lamp (Figure 24) and being an interior lamp – attached to the rear view mirror - (Figure 1);
- the lamp 130 being releasably mounted inside the housing (Figure 1, column 7, lines 36-39); and
- the control module 72a being a lighting control module (Figure 1, column 7, lines 15-18).

Regarding Claims 14-19, DeLine et al. ('886) discloses an integrated light and accessory assembly 500 (Figure 47, column 27, lines 12 and 13) comprising:

- an insulator 510 (Figure 47, column 28, lines 5-16) and reflectors included in lamp 130 or 508h (Figures 1 and 47, column 29, lines 19 and 20) mounted on the insulator 510 (Figure 47)
- the insulator 510 (Figure 47, column 28, lines 13-17). – a circuit board also acting as an insulator – inherently carrying conductors embedded in it;
- at least one lamp 508h (Figure 47, column 29, lines 19 and 20) being connected to the conductor embedded in the insulator 510, and assembled inside the respective reflector included in the lamp 508h (Figure 47);
- an electronic module 508l (Figure 47, column 30, lines 61-64) mounted on the insulator – also a circuit board - and inherently connected to the conductor embedded in the insulator;
- a housing 502 (Figure 47, column 27, line 13) enclosing the reflector, conductor embedded in the insulator 510, lamp 508h and electronic module 508l; - the lamp 508h being an illuminator – reading light – (Figure 47,

column 30, lines 61-64); and conductor and the electronic module 508l receiving electric power through circuit board 510;

- the electronic module 508l being a transmitter for an automatic toll transponder (Figure 47, column 30, line 61 and 62; and
- a video device 508 d (Figure 47, column 29, lines 15 and 16).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLine et al. (U.S. Patent No. 6,124,886).

Regarding claims 6 and 7, dependent on Claim 1, DeLine et al. ('886) teaches an insulator 20 comprising a receptacle connecting in a PC circuit board for various functions with the mounting of mirror assembly (Figures 1 and 30). However, DeLine et al. ('886) does not teach a device mounted to the insulator of the first embodiment of the invention. On the other hand, DeLine et al. ('886) discloses a modular rear-view mirror assembly 270 (Figures 30 and 31, column 17, lines 29-31) comprising a first forward facing light sensor (not shown, column 17, line 49 and 50) extending through the rear

wall 280 (Figure 30); and a second sensor (not shown, column 17, lines 50 and 51) facing rearwardly.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding light sensors as taught by him only for benefits and advantages of advantages of size reduction and economical electronic packaging.

Regarding Claim 8, dependent on Claims 6, DeLine et al. ('886) does not teach in the first embodiment of integrated light and accessory assembly comprising a transmitter. However, DeLine et al. ('886) teaches sixth embodiment of a modular rearview assembly 500 (Figure 47) comprising a transmitter 508I performing automatic toll booth function (Figure 47, column 30, lines 61-64).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding a transmitter as taught by him only for benefits and advantages of advantages of size reduction and economical electronic packaging.

Regarding Claims 11 and 12, dependent on Claims 1 and 11 respectively, DeLine et al. ('886) teaches an insulator 20 comprising a receptacle 92 (Figure 1) connecting in a PC circuit board for various functions with the mounting of mirror assembly (Figures 1 and 30). However, DeLine et al. ('886) does not teach an additional



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functional module connected to an additional conductor mounted on the insulator of the first embodiment of the invention.

On the other hand, DeLine discloses a sixth embodiment of a rearview mirror lamp assembly 500 (Figure 47) comprising a functional module 508l connected to the additional conductor 92 (Figure 1), and performing automatic toll booth function (Figure 47, column 30, lines 61-64).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding a additional module as taught by him only for benefits and advantages of advantages of size reduction and economical electronic packaging.

### ***Allowable Subject Matter***

9. Claims 9,10 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record, including DeLine et al. (U.S. Patent No. 6,124,886), fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose proper motivation for combining:

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- a power storage device, in addition to the main battery of the vehicle, mounted to the housing, and connected to the conductor coupled to the accessories including the rearview mirror device as recited in Claim 9; and
- an additional layer of insulation mounted on at least one conductor, and a ground plane mounted to the additional layer of insulation as recited in Claim 13.

Claim 10 is necessarily objected because of its dependency on the objected base Claim 9.

### ***Response to Amendment***

10. Applicant's arguments filed on December 9, 2002 with respect to the 35 U.S.C. 102(e) rejections of claims 1-7, 9-12, 14-17 and 19; and 35 U.S.C. 103(a) rejections of claims 8, 13 and 18 have been fully considered but they are not considered but are moot in view of the new ground(s) of rejections.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 7:30 - 5:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

2/21/2002

  
Examiner: Hargobind S. Sawhney